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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIC SCHENKEL, CLAIRE POULAIN,
BERTRAND DODELET, and DOMENICO FANARA

Appeal 2014-001930
Application 12/920,524
Technology Center 1600

Before DEMETRA J. MILLS, JOHN G. NEW, and RYAN H. FLAX,
Administrative Patent Judges.

FLAX, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants requested rehearing of the Decision entered November 8, 2016, which affirmed the Examiner's rejection of claims 1, 2, and 4–7 under 35 U.S.C. § 103(a) (hereinafter "Decision"). Appellants' request is denied with respect to making any modifications to the Decision.

Appellants contend the Board's Decision was based on a misstatement of fact and, as a consequence, was a misapplication of the law. Req. Reh'g 1. Appellants contend the Decision is based on the scientifically incorrect statement and conclusion that hydrolytic stability and epimeric stability are so related as to make the stability of the claimed brivaracetam solution, based on hydrolytic stability of piracetam, predictable. *Id.* 2.

The Board did not misstate the facts or misapply the law. As we identified in the Decision, the Specification states:

However, stability storage tests have shown that aqueous solutions of 2-oxo-1-pyrrolidine derivatives were partially unstable. During these tests, ***degradation products in solution are formed by basic or acid hydrolysis, in fact an epimerization and/or amide hydrolysis occurred***, but also oxidation, with detection of hydroxyamide and hydroxyacid impurities.

It has now surprisingly been found that ***these degradation products are not formed at pH values between 4.5 and 6.5***.

FF6 (emphasis added). This statement indicates a relationship between hydrolysis and epimerization in 2-oxo-1-pyrrolidine derivative (e.g., brivaracetam and piracetam) stability. We also recognized that Appellants' witness, named-inventor Schenkel, contended that "the chiral instability is a phenomenon totally independent of the hydrolytic instability" and that "the hydrolytic stability of Brivaracetam and Piracetam does not teach or suggest to one of skill in the art anything about the chiral stability of Brivaracetam." See FF10, FF11. However, "[t]he Board has broad discretion as to the weight to give to declarations offered in the course of prosecution." *In re American Acad. of Science Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) (citing *Velandar v. Garner*, 348 F.3d 1359, 1371 (Fed. Cir. 2003)). Both the Specification and the witness cannot be correct on this disputed issue and in

a battle between the two we find the statement made in the Specification, over two years before the language “epimerically stable” was added to the claims by amendment, more credible.

Moreover, Appellants’ counsel indicated that epimeric stability is “an inherent property of the claim[ed formulation]” and that the claims are directed to “the particular pH range of 4.5 to 6.5 . . . because of the hydrolytic stability as well [as the epimeric stability].” Hr’g Tr. 8:3–21. “Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention.” *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) (citing *In re Prindle*, 297 F.2d 251, 254 (CCPA 1962)). Thus, Appellants’ continued arguments that there is no relationship between hydrolytic and epimeric stability in 2-oxo-1-pyrrolidine derivatives, such as brivaracetam and piracetam, and that stabilizing one such derivative at the claimed pH range would not render doing the same of the other derivative obvious, are not persuasive.

SUMMARY

Appellants’ request is denied with respect to making any modifications to the Decision affirming the Examiner’s rejection.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

DENIED